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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,833	12/06/2005	Clive Edwin Foster	056258-5117	8191

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/559,833

Applicant(s)

FOSTER ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 11 and 13-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/6/05 & 7/24/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references cited in the Search Report dated June 25, 2004 have been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-5, 9, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3-5, 9 and 10, the phrase "selected from" is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. Applicants should note that claim 9 has two occurrences of the phrase "selected from" and all the other claims have one occurrence. The examiner suggests the language "selected from the group consisting of" in place of this phrase.

Also in claim 3, the term "Z" lacks antecedent basis in claim 1. Should this claim be dependent upon claim 2 instead? Please clarify.

Claim 12 is considered confusing since it is dependent upon two different claims. The examiner suggests incorporating the compound of formula (1) as defined in claim 1

into claim 12 or incorporating the composition according to claim 11 into claim 12 to overcome this rejection.

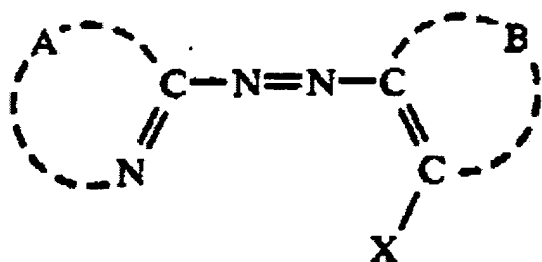
***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US 5,330,542).

Maeda et al. teach a dye composition comprising a solvent and a cyanine type dye and a metal chelate compound of the formula



wherein A is a residue forming a hetero ring together with the carbon atom and the nitrogen atom to which it is bonded such as a pyridine ring which may be substituted with an alkyl group, an alkoxy group, a halogen atom, a cyano group or a nitro group; B is a residue forming an aromatic ring or hetero ring together with the two carbons to which it is bonded such as a naphthalene ring wherein the ring may be substituted with

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an alkyl group, an alkoxy group, an aralkyl group, an aryl group, a halogen atom, a cyano group, a nitro group, an ester group, a carbamoyl group, an acylamino group, a sulfamoyl group, a sulfonamide group or a hydroxyl group; X is a group having an active H and the metal is nickel, cobalt, iron or copper. The dye composition is useful as the dye component in optical recording media, for spin coating and for an optical recording medium. See col. 2, lines 42-68, col. 3, lines 5-50, col. 4, lines 5-12, col. 5, lines 43-50, Table 3, Table 9; compound 35, col. 12, lines 61-67, col. 13, lines 37-41, examples 5 and 7 and claims 1 and 8. Maeda et al. fail to specifically exemplify a metal chelate compound wherein A is a pyridine ring that may be substituted and B is a naphthalene ring wherein the ring may be substituted as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific metal chelate compound wherein A is a pyridine ring that may be substituted and B is a naphthalene ring wherein the ring may be substituted as claimed by applicants as Maeda et al. also discloses the use of these metal chelate compounds but fails to show an example incorporating them.

### ***Allowable Subject Matter***

6. Claims 11 and 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest: (1) a composition

comprising the metal chelate of the formula as claimed by applicants and one or more water-soluble dyes other than the above metal chelate compound; (2) a process for forming an image on a substrate comprising applying an ink containing the metal chelate of the formula as claimed by applicants thereto by means of an ink jet printer; (3) an ink cartridge containing the above composition as claimed by applicants and (4) an ink jet printing containing an ink cartridge containing the above composition as claimed by applicants.

### ***Conclusion***

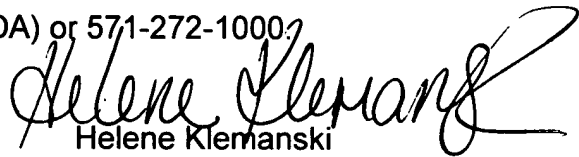
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
October 2, 2006